

REMARKS

I. Overview

Claims 1-21 are pending in this application. In the Office Action dated February 23, 2007, Claims 1-21 were rejected. Applicant hereby traverses the rejections of record and requests reconsideration and withdrawal of such in view of the remarks contained herein.

- Claims 1-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,950,892 to Dourish (hereinafter “Dourish”).
- Claim 19 is rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,396,598 to Kashiwagi et al. (hereinafter “Kashiwagi”).

II. Rejections Under 35 U.S.C. § 102(e)

Initially, Applicant believes that the Examiner made an error by rejecting Claim 19 in view of the Kashiwagi reference. There is no mention of the Kashiwagi reference before this rejection of Claim 19. *See* Current Action, pg. 8. Also, the citations of the Kashiwagi reference (i.e., scanner 12, scanner 36, display unit 10) refer to the Dourish reference. Therefore, Applicant will address the Dourish reference with respect to the Examiner’s rejection of Claim 19. If Applicant’s belief is incorrect, and the Examiner does wish to reject Claim 19 with the Kashiwagi reference, Applicant requests that the Examiner state whether Claim 19 is rejected under 35 U.S.C. § 102 or § 103. Accordingly, Applicant does not waive the right to respond to the Examiner’s rejection of Claim 19 with respect to the Kashiwagi reference.

Claims 1-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by Dourish.

It is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he elements must be arranged as required by the claim,” see M.P.E.P. § 2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with

respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejection does not satisfy these requirements.

Amended claim 1 recites “an image data processor for generating an image file from said image data acquired by said capture element *and modifying said generated image file*; and a user data entry device for enabling a user to modify said generated image file, wherein said at least said one image data capture element, *said image data processor*, and said user data entry device *are disposed within a portable container*.” (Emphasis added). The Dourish reference does not disclose or suggest this limitation. The Examiner believes that the disclosed document reader is the claimed image data capture device, but the document reader does not perform every function of claim 1. *See* Current Action, pg. 3. More specifically, the document reader of Dourish does not modify the loaded documents, but merely records the user input. *See* Dourish, col.4 l.9-35. In Dourish an annotation mechanism 36 located in a document management system modifies the documents according to the user input. *See id.* at col.3 l.21 – col.4 l.43. Accordingly, the disclosed document management system is not part of the document reader and is not a portable device. Thus, the Dourish reference does not teach all of the limitations of amended claim 1. Applicant respectfully asserts that for the above reasons, amended claim 1 is patentable over the 35 U.S.C. § 102 rejection of record.

Claim 13 recites “performing said steps of capturing, receiving, and annotating *within a portable assembly*.” (Emphasis added). The Dourish reference does not disclose or suggest this limitation. The Examiner believes that the disclosed document reader performs the method steps of Claim 13, but the disclosed document reader does not perform an annotating step. *See* Current Action, pgs. 6-7. More specifically, the document reader merely records the user input, but does not annotate the document. *See* Dourish, col.4 l.9-35. In Dourish an annotation mechanism 36 located in a document management system annotates the documents according to the user input. *See id.* at col.3 l.21 – col.4 l.43. The disclosed document management system is not part of the document reader and is not a portable device. Thus, the Dourish reference does not teach all of

the limitations of claim 13. Applicant respectfully asserts that for the above reasons, claim 13 is patentable over the 35 U.S.C. § 102 rejection of record.

Amended Claim 19 recites “[a]n optical scanner comprising . . . means for annotating said displayed selected image data with said superimposed received user-entered data, *wherein said optical scanner is a portable assembly.*” (Emphasis added). The Dourish reference does not disclose or suggest this limitation. The Examiner believes that the disclosed scanners 12 and 36, and display unit 10 make up the claimed optical scanner, but these separate devices are not located in a portable assembly. *See* Current Action, pg. 8. Scanner 12 and display unit 10 comprise the same device of Figure 1, but scanner 36 is an annotation mechanism that is located in a separate device. *See* Dourish, col.3 l.21 – col.4 l.43. The annotation mechanism 36 is located in a document management system, which is not part of the display unit 10 and is not part of a portable assembly. *See id.* Thus, the Dourish reference does not teach all of the limitations of amended claim 19. Applicant respectfully asserts that for the above reasons, amended claim 19 is patentable over the 35 U.S.C. § 102 rejection of record.

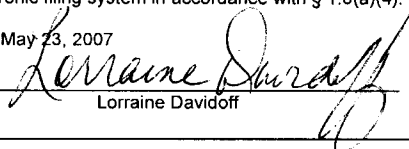
Claims 2-12, 14-18, and 20-21 depend from the base claims 1, 13, and 19, respectively, and thus inherit all limitations of their respective base claim. Each of claims 2-12, 14-18, and 20-21 sets forth features and limitations not recited by Dourish. Thus, Applicant respectfully asserts that for the above reasons claims 2-12, 14-18, and 20-21 are patentable over the 35 U.S.C. § 102 rejections of record.

Thus, the Applicant respectfully asserts that for the above reasons claims 1-21 are patentable over the 35 U.S.C. § 102 rejection of record.

Additionally, Claim 16 has been amended to delete the word “said.” Also, the word “files” has been replaced by “file.” These amendments do not introduce new matter and do not alter the scope of the claim.

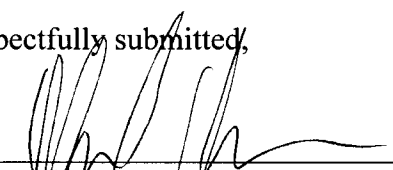
Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10003837-1 from which the undersigned is authorized to draw.

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).	
Dated:	May 23, 2007
Signature:	 Lorraine Davidoff

Respectfully submitted,

By:


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